

09/546,962

T130/TELNP202USA

REMARKS

Claims 1-6, 8-10, 12-18, 20, 21 and 23 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-6, 8-10, 12-18, 20, 21, 23 Under 35 U.S.C. §103(a)

Claims 1-6, 8-10, 12-18, 20, 21, 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Brobst *et al.* (US 6,053,409) in view of Tawara (US 5,710,418). It is respectfully requested that this rejection be withdrawn for at least the following reasons.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, *there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings*. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).* Under 35 U.S.C. §103 where the Examiner has relied on teachings of several references "the Examiner must show reasons that the skilled artisan, confronted with same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed". *In re Rouffet, 149 F.3d 1350, 1357 (Fed.Cir.1998).*

The subject invention generally relates to a piezoelectric scan system. Independent claims 1, 15, 21 and 23 recite similar limitations, namely a piezoelectric scan system that uses *an arcuate reflective surface with variable shape that reflects light onto a beam expander with a generally cylindrical reflective surface*. The subject invention addresses the need in the art for a system and/or method for bar code scanning that employs minimal components while at the same

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time achieving a good depth of the reading field. This is achieved by minimizing the use of motors and other electro-mechanical devices employed to rotate the mirrors and/or lights since they tend to wear over time and may ultimately produce mechanical failures in the scanner as well as minimizing the use of complex geometrical shapes. The cited art fails to teach or suggest applicants' claimed invention.

Brobst *et al.* generally relates to a focusing apparatus for an optical imaging system using a deformable mirror. (See Brobst *et. al* Abstract). Specifically, the cited reference relates to a system for scanning a barcode comprising a light source, a piezoelectric material arcuate reflector, a shape controlling system, and a beam expander that reflects a beam onto a target. In different aspects the beam expander is a polygonal scan mirror mounted on a motor for rotation (Col 3. lines 18 – 20) or an oscillating mirror actuated by a motor for producing the scanning beam (Col 5 lines 1 – 4). However, as noted by applicants' representative in the previous submitted Response to Office Action., Brobst *et al.* fails to teach or suggest a beam expander with a cylindrical reflective outer surface. The beam expander in combination with the piezoelectric reflector in accordance with applicants' claimed invention is able to mitigate the need for actuating motors for mirrors or lights while at the same time providing a same depth of reading field.

Although Tawara use a cylindrical lens, cylindrical mirror or a conical member mounted on a button as a beam expander - Tawara teaches away from applicants' claimed invention by stating that the use of a conical mirror mounted on a mechanically adjustable button is more desirable since it achieves greater depth of reading field (Col 5 lines 25 – 28). Thus both Brobst *et.al* and Tawara resort to mechanically actuated components in order to achieve greater depth of reading field. Nowhere in either of the references is it discussed that a cylindrical beam expander can be used in combination with a piezoelectric material reflector having an arcuate reflective surface will result in a bar code scanner with greater depth of field while at the same time minimizing electro-mechanical devices that may wear out over time. Hence neither of the references would motivate one of ordinary skill in the art to select the elements from them for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir.1998). Absent some teaching or suggestion in the prior art to combine elements, it is insufficient to establish obviousness by claiming that the separate elements of the invention existed in the prior art. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

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Moreover at Page 4 of the Office Action the Examiner has clearly stated that Tawara has been cited in response to the arguments in the Reply to an earlier Office Action that the references cited in that Office Action do not make the claimed invention obvious. Thus, the Examiner employs Tawara to cure the deficiencies of Brobst *et al.* Therefore it is respectfully submitted that the examiner is taking the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability. This sort of rationale as been condemned by the CAFC; see for example, *In re Dembicczak* 175 F.3d 994, 998 (Fed. Cir. 1999).

In view of at least the foregoing, it is readily apparent that the cited references fail to make obvious applicant's invention as recited in the subject claims; therefore this rejection should be withdrawn with respect to the subject claims.

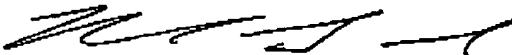
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [TELNP202USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,
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